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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,889	05/09/2001	Fusao Tachibana	01-24 FJA	4293

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EXAMINER

SMITH, JULIE KNECHT

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,889

Applicant(s)

TACHIBANA, FUSAO

Examiner

Julie K Smith

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 9, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the recoil device disclosed in prior art Figure 5 in view of Ida et al. (4,978,864) and further in view of Gotoh (4,491,754). The prior art discloses an engine starter comprising a recoil device, a ring gear (106), operatively rotated with said recoil device, a recoil cover (103) for accommodating said recoil device and said ring gear, and a starter device having pinions (102a) engaged with said ring gear only when the starter device is operated. Prior art Figure 5 is silent as to a drain mechanism.

However, Ida et al. teaches a draining mechanism (see fig. 5) provided on an engine cover for allowing a liquid entering from said recoil cover to be discharged by a one-touch operation.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the apparatus of prior art Figure 5 with the teachings of Ida et al. to provide a drain mechanism on a recoil cover so as to provide means for draining fluid out of the recoil cover.

Prior art Figure 5 discloses an engine starter and Ida et al. discloses a draining mechanism including a plug (18), as claimed above, but does not disclose a drain mechanism including a transparent pipe member. However, Gotoh teaches a drain mechanism including a pipe member attached to an engine cover.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of Gotoh with the reference combination set forth above to provide a pipe member so as to allow the contents of the pipe to be viewed from outside. Further, providing a transparent pipe member would have been obvious to one of ordinary skill in the art at the time the invention was made, as it would have been a matter of design choice to choose a pipe material based on its known properties. Moreover, one of ordinary skill in the art who desired to see the water would have known to use a transparent pipe.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over prior art Figure 5 in view of Ida et al. and Gotoh as applied to claims 2 and 10 above, and further in view of Haynes (US Patent No. 4,757,710). The reference combination set forth above discloses an engine starter as claimed but does not disclose a window for viewing a liquid. However, Haynes teaches the use of a window on an engine cover for viewing liquid levels.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide the starter cover of prior art Figure 5 with a window for allowing the liquid to be visible from the outside so that the drain can be emptied as needed.

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4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over prior art Figure 5 in view of Ida and Gotoh as applied to claims 2 and 10 above, and further in view of Haynes. The reference combination set forth above discloses an engine starter as claimed but does not disclose a window for viewing a liquid. However, Haynes teaches the use of a window on an engine cover for viewing liquid levels.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide the reference combination set forth above with a window for allowing the liquid to be visible from the outside so that the drain can be emptied as needed.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over prior art Figure 5 in view of Ida et al. and Gotoh as applied to claims 2 and 10 above, and further in view of Ide (US Patent No. 4,038,051). The reference combination set forth above discloses an engine starter as claimed above but does not disclose means of forcing the liquid out of the recoil cover.

However, Ide teaches a compressed air injection hole (36, fig. 4) for introducing compressed air to forcibly discharge the liquid inside a cover. Although Ide does not disclose a lid for covering the injection hole, he does disclose a lid (53) for the drain valve. Moreover, it is well known in the art to provide an opening with a lid so as to protect it from foreign matter.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide a compressed air injection hole for introducing compressed air to forcibly discharge the liquid inside a cover so as to remove any contaminants. It would have further been obvious to provide a lid member for closing said compressed air injection hole so as to prevent foreign matter from entering the hole.

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6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over prior art Figure 5 in view of Ida et al and Gotoh as applied to claims 2 and 10 above, and further in view of Ide. The reference combination set forth above discloses an engine starter as claimed above but does not disclose means of forcing the liquid out of the recoil cover.

However, Ide teaches a compressed air injection hole (36, fig. 4) for introducing compressed air to forcibly discharge the liquid inside a cover. Although Ide does not disclose a lid for covering the injection hole, he does disclose a lid (53) for the drain valve. Moreover, it is well known in the art to provide an opening with a lid so as to protect it from foreign matter.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide a compressed air injection hole for introducing compressed air to forcibly discharge the liquid inside a cover so as to remove any contaminants. It would have further been obvious to provide a lid member for closing said compressed air injection hole so as to prevent foreign matter from entering the hole.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over prior art Figure 5 in view of Ida et al., Gotoh and Haynes as applied to claim 3 above, and further in view of Ide. The reference combination set forth above discloses an engine starter as claimed above but does not disclose means of forcing the liquid out of the recoil cover.

However, Ide teaches a compressed air injection hole (36, fig. 4) for introducing compressed air to forcibly discharge the liquid inside a cover. Although Ide does not disclose a lid for covering the injection hole, he does disclose a lid (53) for the drain valve. Moreover, it is well known in the art to provide an opening with a lid so as to protect it from foreign matter.

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Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide a compressed air injection hole for introducing compressed air to forcibly discharge the liquid inside a cover so as to remove any contaminants. It would have further been obvious to provide a lid member for closing said compressed air injection hole so as to prevent foreign matter from entering the hole.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over prior art Figure 5 in view of Ida et al, Gotoh and Haynes as applied to claim 4 above, and further in view of Ide. The reference combination set forth above discloses an engine starter as claimed above but does not disclose means of forcing the liquid out of the recoil cover.

However, Ide teaches a compressed air injection hole (36, fig. 4) for introducing compressed air to forcibly discharge the liquid inside a cover. Although Ide does not disclose a lid for covering the injection hole, he does disclose a lid (53) for the drain valve. Moreover, it is well known in the art to provide an opening with a lid so as to protect it from foreign matter.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide a compressed air injection hole for introducing compressed air to forcibly discharge the liquid inside a cover so as to remove any contaminants. It would have further been obvious to provide a lid member for closing said compressed air injection hole so as to prevent foreign matter from entering the hole.

Allowable Subject Matter

9. Claims 9, 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 12/24/02 have been fully considered but they are not persuasive.

Regarding claim 2, providing a transparent pipe member would have been obvious to one of ordinary skill in the art at the time the invention was made, as it would have been a matter of design choice to choose a pipe material based on its known properties.

Regarding claims 3 and 4, in response to applicant's argument that the window of Haynes does not have the purpose of monitoring muddy water, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claims 5-7, Ide clearly states (column 6, lines 13-23) that the force of the compressed air within the housing flushes out the water, oil, and solid particles collected in the sump.

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Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

GB 2 274 251 to Redding et al.

4,676,205 to Kaufman

5,386,881 to Eshelman

5,285,636 to Mayo et al.

4,789,363 to Wicklein

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Smith whose telephone number is 703-305-3948. The examiner can normally be reached on Monday-Friday, 8-5:30, (Every other Friday off).

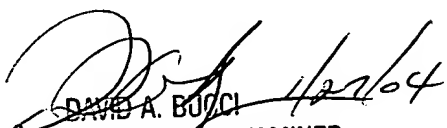
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

JKS

Jks

January 26, 2004


DAVID A. BUCCI
SUPERVISORY PATENT EXAMINER
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